Remarks

1) Summary of Office Action

Claims 36 to 57 are currently pending in this application. In the Office Action of July 18, 2007, all of claims 36 to 57 were rejected under 35 U.S.C. 103(a) as being obvious in light of various combinations of references, as follows:

(a) Claims 36 to 39, 41 and 42 are rejected as being obvious given US 4,796,758 of Hauk in light of any one of (i) US 5,090,526 of Jacober (No.1); (ii) US Des. 412,267 of Anderson; or (iii) US 3,213,641 of Agee.

(b) Claim 40 stands rejected in view of the references as applied in respect of claims 36 to 39, 41 and 42 and further in view of US Patent 6,015,072 of Young.

(c) Claims 43 – 46 and 48 – 57 stand rejected given US 5,865,314 of Jacober (No. 2) in light of any one of (i) Jacober No. 1; (ii) Anderson, supra, or (iii) Agee.

(d) Claim 47 stands rejected given the art as cited against claims 43- 46 and 48 – 55 and further in view of US Patent 6,092,661 of Mogil.

2) Amendment to the Disclosure - Corrected Claim for Priority

It appears that the claim for priority previously submitted in this case, and echoed in the disclosure at paragraph [0001] as published in US Publication 2004/0035143 was incorrect. Clearly this case was intended to be a direct continuation of US patent application 09/881,770 with which it shares its disclosure and set of illustrative figures. A petition under 37 CFR 1.78 (a)(3), and the payment required under 37 CFR 1.17(t) are submitted herewith to make the correction as an unintentionally delayed claim for priority.

3) **Cross-Referenced IDS – Eddie Bauer Product**

In view of the correction to the claim for priority, the Applicant asks that the Examiner confirm that all of the art of record in the parent, grandparent, and other cases in this family has been brought forward against this case and considered by the Examiner. In particular, the Applicant draws to the Examiner's attention the cover letter of the IDS submission of September 20, 2002 in the immediate parent case, 09/881,770 (now US Patent 6,644,063) in which reference is made to the lunch bucket product of another company, Eddie Bauer. A copy of this submission is enclosed for the Examiner's convenience.

4) **Amendments to Claim 43**

Claim 43 previously recited a "soft-sided insulated container" in the preamble, and recited a "second insulated chamber", but did not recite a "first insulated chamber". The first subclause of claim 43 has been symmetrically amended to identify the upper and lower portions as soft-sided insulated portions. The first chamber is thereafter referred to as the "first insulated chamber", consistent with the "second insulated chamber".

5) **Comments on Rejections Under 35 USC 112 - Claim 57**

Claim 57 has been rejected under 35 USC 112 as failing to comply with the enablement requirement. In particular the Examiner objects to the term "tracked fastener" as being unsupported by the disclosure.

The Applicant respectfully disagrees. The disclosure shows and describes several tracked fasteners e.g., zippers **612**, **614**. The Applicant requests that the rejection under 35 USC 112 be reconsidered and withdrawn.

6) General Traverse and Reservation of Rights

The Applicant respectfully traverses all of the present rejections, and requests their reconsideration and withdrawal. Notwithstanding the amendments made herein, the Applicant reserves its right to pursue any or all of the present claims as they stood prior to amendment by way of division or continuation at such time as may be appropriate. The Applicant explicitly does not intend by these amendments to surrender any scope under the doctrine of equivalents either with respect to the claims as they formerly stood, or with respect to the claim scope to which the Applicant would have been entitled had the claims been originally submitted in the manner in which they stand as amended.

7) All Rejections Made Under 35 USC 103

The Applicant notes that the Office Action relies only upon 35 USC 103(a). The Applicant understands this to be an admission that none of the art of record anticipates the presently pending claims under 35 USC 102. The issue then is not whether the claims encompass novel subject matter, but rather whether that novel subject matter is inventive. Thus there is an inquiry into obviousness.

(a) Tests for Non-Obviousness

In an analysis of obviousness or non-obviousness the law requires that the scope and content of the prior art be determined; that the differences between the prior art and the claims be ascertained; and that the level of ordinary skill in the art be resolved in order to assess what would, or would not be obvious to a person of ordinary skill in the art. (*Graham* v. *John Deere*, 383 US 1, 17 – 18, 86 S. Ct. 684; *KSR* v. *Teleflex* 127 S. Ct. 1727.) This analysis is informed by secondary factors, such as commercial success and long felt but unsolved needs, the failure of others, and so on, that may be used to give light to the circumstances surrounding the origin of the subject matter to be patented, and may have relevancy as indicia of non-obviousness.

Where a rejection is made under 35 USC 103(a) on the basis of obviousness in light of a proposed modification of a reference or a combination of references, the law requires that a three branch test be satisfied to establish a rebuttable *prima facie* ground for rejection. First, all of the features of the claimed invention must be present in the prior art. Second, the proposed modification or combination must hold out a reasonable prospect of success. Third, there must be some reason provided in the rejection to explain why a person of ordinary skill in the art would make the modification or combination.

If there is teaching, suggestion or motivation demonstrated in the art itself, or in the demonstrable knowledge of persons of ordinary skill in the particular art or science generally, to make that modification or combination, then that may provide the required reason. However, while a requirement for a showing of teaching, motivation or suggestion in the prior art captures a useful insight, and while it has been applied on many occasions in a manner consistent with the decision of the Supreme Court in *Graham* v. *John Deere*, supra., rigid adherence to a requirement for teaching suggestion or motivation is not always appropriate. A reason to modify or combine can be found outside the prior art. The reason to combine or modify need not necessarily be the same as that of the inventor whose claims are being challenged. (See *KSR* v. *Teleflex*, supra). Only after *prima facie* grounds of rejection are established does the Applicant bear a burden of rebutting those grounds.

(b) **References To Be Read As A Whole**

In evaluating the prior art, references must be read as a whole. There can be no finding of obviousness where a reference teaches away from the proposed modification or combination, (See *Gillette* v. *S.C. Johnson* 919 F.2d 720 at 724 (Fed. Cir. 1990; *In re Geisler* 116 F.3d 1465 at 1469 (Fed. Cir. 1997)) or where the proposed modification or combination would destroy the functionality of the reference for its own purpose. (See: *In re Gordon* 733 F.2d 900 at 902; 221 USPQ 1125 at 1127, (Fed. Cir.1984)).

(c) **Picking and Choosing Is Not Permitted**

A rejection made on the basis of obviousness is necessarily an exercise in fiction, because it involves speculating what a person skilled in would have done "if" ... The inherent artificiality of the inquiry is well known: An examiner is to read the claims as if the examiner were a person the examiner is not, namely the hypothetical person of ordinary skill in the art (itself an artificial legal construct), in a world that has no knowledge of the Applicant's disclosure (not possible once the examiner has picked up the case for examination). Under these circumstances, the tendency to engage in impermissible hindsight analyses is very great, and occurs exceedingly frequently.

Courts have long grappled with this problem. Since inventions often tend to be notoriously easily understood in hindsight, the law has repeatedly warned against the dangers of hindsight analysis (also noted in *Graham* v. *John Deere*, supra). One protection against hindsight analyses is that the law *requires* that references be read as a whole: it is impermissible within the framework of s.103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (*In re Wesslau*, 353 F. 2d 238; 147 USPQ 391 (CCPA 1965)). *Chisum on Patents* lists no less than 17 decisions by the Court of Appeals for the Federal Circuit excoriating hindsight analyses. (See *Chisum on Patents*, vol. 2, ch. 5.03[2][c], pp 5 – 105 – 106, footnotes 25 and 26.)

"Measuring a claimed invention against the standard established by section 103 requires the oft difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of *less technologically complex* inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Life Technologies Inc.* v. *Clontech* 224 F.3d 1365 at

1369; 55 USPQ 2d, 1313 at 1316 (Fed. Cir. 2000). (Internal citations omitted, emphasis added.)

(d) **Impermissible Hindsight Combination**

"**Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention**" *Crown Operations Int'l Ltd.* v. *Solutia Inc.*, 289 F.3d. 1367 at 1376; 62 USPQ 2d 1917 (Fed. Cir. 2002).

The Applicant respectfully submits that it is difficult enough to show a credible reason for combination of two references. The combination of three references is improbable at the best of times. The combination of four references would require a very high level of support in the cited references.

8) **Commentary on References and Rejections**

The Office Action of July 18, 2007 does not address all of the Applicant's arguments presented in the Amendment of June 18, 2007. Although the Applicant continues to disagree in substance with the reply commentary, the Applicant acknowledges that the reply commentary makes an effort to address whether the first Jacober reference shows a downwardly widening profile.

(a) Internal Inconsistency of Rejection of Claim 43

Claim 43 is rejected on the basis of Jacober (No.2) in view of Jacober (No. 1). In the interests of brevity, the Applicant incorporates by reference herein the arguments presented in the Response of June 18, 2007.

The Office Action, page 9, lines 17 – 18, speaking of the Jacober (No.2) reference says:

" … ; said rectangular bottom wall being *permanently connected* to said rear margin (as seen in Figures 1, 3, 4); …" (Emphasis added).

In the same rejection, at page 10, lines 13 – 16, speaking of Jacober (No. 1) the Office Action says:

"Access to the interior of the container can be gained upon unzipping the container's closure member (33 – zipper), which further allows for the shelf member to be detached (via snap fasteners [52]) …"

But the "*permanently connected*" panel of the claim is the very same panel as the "shelf member" that is "*to be detached*".

Which is it ? Is the bottom panel of the top portion "*permanently attached*" ? Or is it "*to be detached*" ?

It cannot be both.

This is a clear internal contradiction in the rejection of claim 43.

The Applicant respectfully submits that a rejection that is based on an internal contradiction cannot be sound. The Applicant therefore requests that the rejection be reconsidered and withdrawn.

(b) Inconsistency between Rejections of claims 36 and 43

The interpretation of the Jacober (No.1) reference as applied to claim 36 is internally inconsistent with the interpretation of the Jacober (No.1) reference as applied to claim 43. The Office Action of June 18, 2007 does not address this point. That is:

(i) Office Action, page 6, lines 10 – 14, speaking of the Jacober (No. 1) reference and claim 36:

"Further disclosed is that upon unzipping the container's closure member (33 – zipper), users can gain access to the interior of the container wherein the shelf member *can be detached* (via snap fasteners [52]) and folded so as to allow the container to be compressed for storage purposes *or for the insertion of larger items* (as seen in Figures 4, 5)." (Emphasis added.)

(ii) As noted above, claim 43 is rejected given Jacober (No.2) in view of Jacober (No. 1). The Office Action, page 9, lines 17 – 18, speaking of the Jacober (No.2) reference and claim 43 says:

" ... ; said rectangular bottom wall being *permanently connected* to said rear margin (as seen in Figures 1, 3, 4); ..." (Emphasis added).

But the secondary reference relied upon in making this rejection is Jacober No. 1, which the Office Action has just told us teaches that the panel is *detachable*, and provided a rationale for adopting such a feature. Now, in the context of claim 43, that previous teaching, and the rationale volunteered in the Office Action in the context of claim 36 is to be ignored.

This is simply untenable.

The law requires (a) that references be read as a whole; and (b) that the interpretation of references be consistent from claim to claim. The entire fictional exercise of making a rejection under 35 USC 103 rests upon the assumption that an assessment of the probable behaviour of a person of ordinary skill in the art can be made on the basis of interpreting prior art, and on the basis of objective evidence of the general knowledge of persons of ordinary skill in the art. If we say that the person of ordinary skill would understand a reference to teach 'X" one minute, we cannot turn around and pretend in the next minute that it does not teach 'X'. To do so is to cut the analysis loose from logic and turn it into an exercise in arbitrary fiat unconnected to any legal underpinning. Either we have a consistent set of facts or we do not.

This is a clear internal contradiction in the Office Action. The Applicant therefore requests that one or the other (or, better still, both) of these rejections be withdrawn, since they cannot both be sustained. Therefore, the Applicant again asks, is the rejection of February 16, 2007 intended to (a) reject claim 36; or (b) allow claim 43; or (c) both ? If not, then the Applicant again asks how the two rejections can stand side by side without contradicting each other. **The Applicant again respectfully requests that this specific point be addressed in a <u>non-final</u> Office Action**.

(c) <u>Claim 36 and Claim 43: Rationale Inconsistent with Claimed Invention: Office Action itself indicates that reference teaches away</u>

The rationale in the Office Action is simply inconsistent with claim 36. If the internal removable shelf of Jacober (No. 1) is said to correspond to the rectangular bottom wall panel of the top portion of the container, then how can the first chamber be fully segregated from the second chamber (as recited in claim 36) once the panel is removed ? Pointing out that removal of the panel permits "larger food items" to be enclosed therewithin, is plainly inconsistent with (i.e., teaches away from) the recited claim feature that the first and second chambers are fully segregated from each other. If the panel is removed then either (a) there are no longer two chambers or (b) the two chambers are not in any way (let alone fully) segregated from each other.

In essence, the commentary in the Office Action at page 7, lines 17 -18, is an admission in the record that Jacober (No. 1) teaches away from the fully segregated chambers of the invention of claim 36. It is also an admission that Jacober (No.1) teaches away from the permanently attached bottom wall of the top portion of the insulated container of invention of claim 43. Inasmuch as teaching away is a clear and long established indicator of non-obviousness, the Applicant respectfully requests that the rejection of claim 36 (and, indeed, the rejection of claim 43) be withdrawn on the basis of that teaching away as indicated in the Office Action.

Alternatively, if either the rejection of claim 36 or the rejection of claim 43 should be sustained, the Applicant respectfully requests an explanation of how a rejection under 35 USC 103(a) can be based upon reasoning in the Office Action itself that relies on one of the references *teaching away* from claimed features of the invention.

(d) Impermissible Hindsight Analysis

As noted above, in all instances, the law requires that references be read as an whole. It is never permissible to pick and choose this feature or that feature from a reference selectively. In the previous response to Office Action (incorporated herein by reference) the Applicant pointed out a list of inconsistencies between the teaching of the Jacober (No. 1) reference and the claimed invention, and a list of inconsistencies between the teachings of the Hauk reference and the claimed invention. The rejection in the Office Action can only be made by selective picking of the features of the Hauk reference, and combining them with features picked from the Jacober reference, without any real demonstration of a rationale why any person skilled in the art, and lacking foreknowledge of the invention, would ever be prompted spontaneously to make any such combination. Given the reliance on a rationale that, apparently, teaches away from the invention, and given the lack of a consistency in the rationales provided both internally in claim 43, or as between claims 36 and 43, the inference is unmistakeable that the rejections have been assembled on the basis of cherry picking, rather than according to law.

The Office Action does not address this point.

(e) Claim 36 - Failure to Establish Required Elements of Test Under 35 USC 103

Taking claim 36 as an example, the Office Action would have the reader believe that the claim is rejected under 35 USC 103(a) given

(1) Hauk (US Patent 4,796,758) in view of Jacober (US 5,090,526); or

(2) Hauk in view of Anderson (US Des. 412,267); or

(3) Hauk in view of Agee (US Patent 3,213,641).

The Office Action suggests that any of these combinations is sufficient to provide a basis for rejection. Yet these references teach very different things.

As noted above, the test for establishing *prima facie* grounds of rejection under 35 USC 103(a) still requires (a) that all of the features of the claim be shown or described in the cited art or in the objectively demonstrated knowledge of persons skilled in the art generally; (b) a reasonable likelihood of success; and (c) a logical reason <u>why</u> a person skilled in the art would make the proposed combination or modification.

How, for example, could any person skilled in the art arrive at the use of a soft-sided insulated container on the basis of reading <u>Hauk and Agee</u> ? Hauk teaches a rigid box. Agee shows an old fashioned rigid lunch bucket. No matter how the references are combined, they would not yield a soft-sided insulated container, which is the starting point of the exercise. The combination would be missing at least one element of the claimed invention, and could not therefore serve as a basis upon which to establish *prima facie* grounds of rejection under 35 USC 103.

How, for example, could a person skilled in the art, having no foreknowledge of the invention, look at <u>Hauk and Anderson</u> and arrive at the invention ? Neither one teaches a soft-sided insulated container having the upper portion profile required. No matter how they are combined or modified, they would still be missing at least one feature of the claimed invention. They could not, therefore, serve as the basis of establishing *prima facie* grounds of rejection.

How, for example, could a person skilled in the art, and having no foreknowledge of the invention look at <u>Hauk and Jacober</u> and arrive at claim 36 ? Even accepting that the rejection clearly uses the Applicant's claims as a roadmap (itself improper), it nonetheless still relies upon a rationale for combination that *teaches away* from the claimed invention!

Clearly this does not properly establish *prima facie* grounds for rejection under 35 USC 103(a).

None of these combinations meets the test for establishing *prima facie* grounds of obviousness. There is no independent logical nexus between Hauk and Agee. There is no independent logical nexus between Hauk and Anderson. There is no independent logical nexus between Hauk and Jacober. The only inference that can be made is that these references, and the features of these references upon which the rejections rely, were chosen on for the sole purpose of assembling a selective mosaic, for which the Applicant's claims served as a road map. This is forbidden by law.

(e) Newly Cited Art – General Commentary

The Applicant does not see how the newly cited Agee and Anderson references form the basis of alternate forms of rejection of the various claims.

(i) Agee

Contrary to the commentary on page 10 of the Office Action, L.E. Agee does not disclose a soft-walled carrier. US Patent 3,213,641 of Agee shows a conventional dome-roofed lunch box with an insulated lower compartment insert. Agee tells us that "Another object [[of Agee's invention]] is to provide an insulated container which may be utilized in the casing of a conventional lunch box." (Col. 1, lines 30 – 32). A conventional lunch box in 1963 was a rigid container, typically made of sheet metal. Agee says as much – noting that the casing **10** "may be formed in plastic, light-weight metal or tin." (Col. 2, line 2).

Agee shows and describes an un-insulated dome compartment in which there is a clip mounting for a vacuum bottle – e.g., a Thermos® bottle..

Agee's insulated insert is, apparently, substantially rigid, as may be inferred from the use by Agee of a gasket 31. (Col. 3, lines 26 - 28).

What Agee teaches is a hard sided, sharp cornered traditional lunch box with internal insulation. This is, in many ways, the antithesis of the present invention.

(ii) Anderson

Anderson is a Design patent. It has no detailed description, and no written description beyond the brief description of the illustrations. Anderson shows an "Insulative Container". It has a single compartment, and a flat, hinged lid. Ironically, the Office Action does not actually refer to Anderson's invention, but rather to the environment feature of a lunch box shown in phantom lines in Anderson Figure 20.

The Applicant respectfully submits that a person skilled in the art might reasonably believe that the object shown in phantom is a single chamber, hard shell uninsulated lunch box, for which Anderson's invention is, in effect, a soft-sided insulated liner. Combining the selected feature of Anderson with Hauk would not then yield the present invention, no matter how they are combined.

The citation of this feature in Anderson could hardly be a better example of that which is forbidden by *In re Wesslau* and by *Crown Operations*. How is it conceivable that a person of ordinary skill in the art, reading the Anderson document as a whole, would, without knowledge of the presently claimed invention, understand that it is teaching that a feature shown in one Figure, the very last of 20 Figures, shown in phantom (!), and for which there is no substantive written detailed description, is to be incorporated in an utterly unrelated, totally dissimilar object from another reference to arrive at the claimed invention?

The Applicant respectfully submits that there is no credible support provided in the Office Action for the proposition that a person skilled in the art, reading Anderson as a whole and having no knowledge of the claimed invention, would understanding that the identified feature should be combined with Hauk at all, whether that combination led to the invention of claim 36, or any other.

(f) <u>Other Commentary Concerning the Rejection of Claim 36</u>

(i) The Office Action concedes that "Hauk does not expressly disclose: - the container is soft sided…" While this admission is welcome, it rather understates the facts.

Not only does Hauk not disclose a soft-sided container, but, more strongly, several comments in Hauk point to a rigid container. Hauk explicitly refers to the lower portion as an "insulated chest". (See, Hauk, Abstract, col. 3, lines 43 – 56, 60; col. 4, lines 4 and 19). Hauk also indicates that "The interior and exterior corners of the chest 24 are rounded, so as to provide maximum exposed surface area for the chilling of expressed human milk and *so as to press and conform* the chilling means to the storage bottles." (Col. 3, lines 50 – 54). (Emphasis added.)

This description appears not merely neutral (as the Office Action would imply) but inconsistent with the Hauk apparatus being a soft-sided insulated container. The term "insulated chest", and the stiffness implied in the phrase "… to press and conform the chilling means…", appear to indicate that the object is substantially rigid, not soft-sided.

Clearly the Hauk reference also lacks the downwardly concave profile set out in the claims.

(ii) The Office Action states at page 7, lines 4- 8 that:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the existing apparatus of Hauk by insulating the upper portion of the apparatus as taught by Jacober ('526), or Anderson or L.E. Agee to more thoroughly insulate the contents enclosed within, thus increasing apparatus' efficiency and making it more user-compatible."

Leaving aside the question of modification or combination of any of the references, this statement is misleading in at least two respects. First, Anderson does not have an "upper portion of the apparatus". Anderson has a single portion, with a flap. Given that Anderson does not have an upper portion, it necessarily follows that Anderson can not teach "insulating the upper portion" that he does not have. Second, Agee does not teach an insulated upper portion, either. Agee has an uninsulated upper portion that has an internal clip **12** for holding a Thermos® bottle.

To the extent that the references to Anderson and Agee are unfounded, their inclusion in the rejection merely serves to undermine the credibility of the reference to Jacober: It is clear that the wrong methodology has been employed in making the rejection, otherwise Anderson and Agee would not have been cited. Clearly then, entire rejection has been made on the same unsound basis.

(iii) In speaking of Jacober No. 1, the Office Action states at page 6, lines 14 – 15 that "In addition, the shelf member is seen to conform to the outline defined by the carrier's side and top panels." While this is interesting, it is not what is claimed in claim 36. Claim 36 requires that the rectangular panel conform to the lower margins of the end walls and spanning wall of the upper portion of the soft-sided insulated container. Jacober does not have any such margins.

To the extent that this rejection maybe sustained, the Applicant respectfully requests that any subsequent office action include marked up copies of Figures from Jacober demonstrating where the lower margins of the panels in question are shown.

(iv) Contrary to the interpretation on page 10 of the Office Action, the bottom wall (20) of Jacober No. 1 is not analogous to the bottom wall of the upper portion of the insulated soft-sided container recited in claim 43. The bottom wall (20) is, by the interpretation given in the Office Action, the bottom wall of the lower portion of the claimed container.

(v) Contrary to the interpretation on page 10 of the Office Action, claim 43 claims that the upper portion of the entire container is hingedly connected to the lower portion. The claim also defines the bottom panel of the upper portion as also defining the top panel of the bottom portion. The claim also requires that the bottom wall (i.e., of the upper portion) and the end walls (also of the upper portion) are movable relative to the lower portion when the second closure is in an open position. Clearly, when the closure member identified in the Office Action in Jacober No. 1 is opened, this condition cannot be met. Indeed, it cannot be met whether that closure member is open or closed, since, at the very least, the end wall at the far end is monolithic.

Therefore, it appears that the Office Action is based on an incorrect understanding of the claim, or of the reference, or perhaps both.

(g) <u>Other Commentary Concerning the Rejection of Claim 43</u>

Claim 43 is rejected on the basis of Jacober (No. 2) in view of Jacober (No. 1) or Anderson or Agee. The Applicant has already noted the internal inconsistency in the rejection of claim 43, and, on that ground alone if no other the Applicant respectfully requests that the rejection of claim 43 be reconsidered and withdrawn. The Applicant has also previously noted that the rationale for combination provided in the Office Action in the rejection of claim 36 actually teaches away from the claimed invention not only of claim 36 but also of claim 43. The Applicant adds the following further grounds to show that the rejection of claim 36 is not properly founded

(i) <u>Teaching Away - Second Insulated Chamber</u>

The Office Action asserts that Jacober No. 2 has a "second insulated chamber". The grammatical issue is that to have a "second insulated chamber" there must first be a "first insulated chamber". Jacober No. 2 clearly does not have a "first insulated chamber". Jacober No. 2 actually explicitly teaches away from having a second insulated chamber (col. 1, lines 63 – 65):

"It is a still more specific object of the present invention to provide an injectable medication carrying case which has both a cool side and a room temperature side."

As such, Jacober No.2 cannot form the basis of a rejection under 35 USC 103.

(ii) No downwardly widening profile

Jacober (No. 2) teaches a two part soft-sided container. The Office Action appears incorrectly to state that Jacober (No.2) has a "top wall extending between said first and second opposed walls and defining a widening profile (as seen in Figures 1,3)." The Applicant has reviewed Figures 1 and 3 of US Patent 5,865,314 of Jacober, and has yet to identify the features to which the Office Action refers. In the event that this rejection is sustained, the Applicant respectfully requests that the Examiner provide marked up copies of Figures 1 and 3, identifying these features.

The Office Action also alleges that each of the side walls has an upper edge conforming to the widening profile of the top wall portion. This appears also to be incorrect: the side walls have an upper edge that is flat as far as the Applicant can tell.

(iii) Panel Margins

The Office Action also alleges that the front and rear margins of the top wall are "located upwardly of the respective first and second ones of said long sides of said bottom wall". This is not what the claim says. The claim indicates that the front and rear margins conform to the long sides of the bottom wall. As far as the Applicant can tell, this is not the case in Jacober No. 2.

(h) Claim 56

There is no substantive basis provided in the Office Action for the rejection of claim 56 or for the art based rejection of claim 57.

The Applicant respectfully requests that without being provided with a basis for rejection, the Applicant is not placed in a position where the applicant has a full and fair, non-final opportunity to traverse the rejection. This is a fundamental requirement of procedural fairness. By definition, if the rejection is silent, it cannot possibly have established *prima facie* grounds for rejection of the claim.

The Applicant therefore respectfully requests that the grounds of rejection of claims 56 and 57 be fully stated, and that the Applicant be given a full and fair, non-final opportunity in which to respond to those grounds, whether by amendment or by argument, or both.

(i) Dependent Claims

The Applicant respectfully traverses all of the rejections of the various dependent claims. The proposed combinations upon which the rejections of those claims are based have no more rational support in the references that the rejections of the independent claims. To the same extent that the Office Action fails to demonstrate prima facie grounds for the rejections of the independent claims, so too is a demonstration of prima facie grounds for rejection of the dependent claims also lacking.

The Applicant expressly reserves the right to submit other and further arguments with respect to the individual dependent claims as such time as may be appropriate.

(j) **Commercial Success**

As noted above, rejections made under 35 USC 103(a) are inherently exercises in fiction. Where prima facie grounds of rejection are established, the law under *Graham*, is such that secondary factors may be relied upon to overcome such a rejection. One such factor is commercial success.

In the instant case, various embodiments of the underlying commercial product line have sold over 5 million units in the Untied States and Canada, with a value in excess of US $ 25 million since 1999. This product has had outstanding success in its market segment. These products are, and were, a significant advance over the Eddie Bauer product, and had remarkable sales acceptance in the market in a very short period of time.

This is admittedly a modest invention. It is perhaps the kind of "*less technologically complex*" invention to which the case law refers in warning of the particular danger of hindsight analyses. But it is an invention nonetheless, and it is entitled to protection under the law the same as any other invention. The present claims are very, very narrow. They are easily avoided, and can be avoided at no discernible incremental cost. The Applicant is not claiming the moon. The Applicant is claiming a monopoly over soft-sided insulated lunch buckets that have a dividing wall between the top and bottom portions of the container where that dividing wall defines the bottom wall of the upper compartment. As far as the Applicant is aware, this is not shown or described in the prior art.

The Applicant admits that there is a large population of prior art. This is undoubtedly a crowded field. What often fails to be appreciated is that it is <u>not</u> that various individual elements are not known in one piece of prior art or another. Rather there is so much art that it becomes the needle-in-a-haystack problem. Finding the winning path through the jungle of prior art to the successful combination of features is often a matter of great intuition and skill. The difficulty of creating successful new products is sometimes not appreciated by those who have not tried the same exercise. It is also often a mater of dogged trial and error. The differences between one product and another may appear to

be very small, yet one product fails miserably, and the other product is wildly successful under the same conditions in the same market.

There is often a tendency to regard modest inventions such as the present one as being of no importance. They lack, perhaps, the glamour of electronics or pharmaceuticals. Somehow these inventions are seen as being unworthy of protection because they lack apparent sophistication. This is a grossly unfair prejudice. The owners of this invention have employed creativity and hard work to develop a very successful product, the same as in any other industry. Even though this is a modest invention, it is a good one. It is novel, useful, and unobvious, and has been rewarded by quite significant commercial success in the market accordingly.

The Applicant therefore once again respectfully requests that the current rejections be reconsidered and withdrawn, and the claims allowed.

In the event that this paper is not being timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account Number 01-2300, referencing Docket Number 027699-00005.

Respectfully submitted,

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Enclosure: Information Disclosure Statement of September 20, 2002, from U.S. Patent Application No. 09/881,770

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Melvin S. MOGIL

Application No.: 09/881,770

Filed: June 18, 2001

For: DIVIDED INSULATED CONTAINER

Group Art Unit: 3744

Examiner: C. Jiang

Atty. Dkt. No.: 100570-00020

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
Washington, D.C. 20231

September 20, 2002

Sir:

Pursuant to 37 CFR §1.56, the attention of the Patent and Trademark Office is hereby directed to the information item(s) listed on the attached PTO-1449. Unless otherwise indicated herein, one copy of each item(s) is attached. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the item(s) be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

☒ 1. This Information Disclosure Statement is being filed (a) within three months of the U.S. filing date or the date of filing a CPA, OR (b) before the mailing date of a first Office Action on the merits in the present application, or (c) accompanies a Request for Continued Examination. No certification or fee is required.

☐ 2. This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection or Notice of Allowance.

☐ a. I hereby certify that each item of information contained in this Information Disclosure Statement was cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(1).

☐ b. I hereby certify that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(2).

☐ c. A check in the amount of $180.00 in payment of the fee under 37 CFR §1.17(p). Please charge any fee deficiency or credit any overpayment to Deposit Account No. 01-2300 as needed to ensure consideration of the disclosed information.

☐ 3. This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. Applicant(s) hereby petition(s) that the Information Disclosure Statement be considered. Attached is our check in the amount of $130.00 in payment of the petition fee under 37 CFR §1.17(i)(1). Please charge any fee deficiency or credit any overpayment to Deposit Account No. 01-2300 as needed to ensure consideration of the disclosed information.

☐ a. I hereby certify that each item of information contained in this Information Disclosure Statement was cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(1).

☐ b. I hereby certify that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(2).

☒ 4. <u>"Eddie Bauer Lunch Bucket Product"</u>

The applicant has seen a product produced by another company, Eddie Bauer. To the best of applicant's recollection, the product was a soft-sided insulated container having the general shape of a lunch bucket. That shape had a generally rectangular base where the length was longer than the width. The bottom portion had vertically upstanding side walls having a height that was comparable to the length of the short side of the base, whether somewhat greater or somewhat less, such that the bottom and four side wall panels form a rectangular, open topped box.

The box had a dome lid. The dome lid had a rectangular footprint that matched the rectangular opening of the lower part of the box. The dome lid was hingedly attached to the upper edge of the rear long side of the box. The other three sides were joined by a zipper to the bottom portion of the box. The zipper could be opened to let the domed lid move about the hinge to an open position. Inside the lunch bucket was a loose sling of straps for keeping objects (e.g., a canned drink) from falling out of the dome when the lunch bucket was closed.

In the event that any fees are due with respect to this paper, please charge our Deposit Account No. 01-2300, referencing our docket number of 100570-00020.

Respectfully submitted,

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC

SIGNATURE ON ORIGINAL

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